

REMARKS

This amendment is responsive to the Office action mailed September 1, 2004 for the above-captioned application.

- Claim 1 has been objected to based on informalities.
- Claim 1-17 have been rejected under 35 USC 103(a)
- Claims 1, 4, 6, 8, 9, 15, 16 and 17 are amended.
- No claims are added.
- No claims are canceled.
- Claims 1-17 remain pending.

Claim 1 has been objected to for informalities. Such informalities have been corrected as per the examiner's suggestion.

The Cited Art and the Claims Distinguished

The following discussion is organized according to the six rejections listed in the official action.

A. Claims 1-3 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,185,605 (Kowaguchi) in view of US Patent No. 6,779,178 (Lloyd et al.).

Kowaguchi discloses an electronic mail system that forwards an electronic mail to a receiving communication terminal. A transmitting communication terminal calls an electronic mail server, confirms whether the line is connected, and transmits an electronic mail to the electronic mail server. (Col. 6, lines 10-15). The electronic mail server stores the electronic mail and the destination address, (Col. 6, lines 37-38). Account information is extracted from the destination address, and a conformation is performed to determine whether the account is registered to have a corresponding address and telephone number, (Col. 6, lines 40-45). The server then calls the phone number corresponding to the destination address and sends the e-mail as part of an automated distribution function, (Col. 6, line 59-67; Col. 7, line 62 to Col. 8, line 4). The registered user receiving the e-mail alternatively can select a reception-informing mode to receive an indication that an

electronic mail has been received at the server for the user, (Col. 7, lines 45-49).

Lloyd et al. discloses a system for personalizing electronic mail messages by incorporating personalized images, such as handwritten signatures into existing e-mail messages. In one embodiment, Lloyd et al. allows a user management tool to connect to a web server using HTTP protocols. The management tool encodes the image. (Col. 27, lines 3-7). Once encoded, the management tool performs a POST operation to a CGI script. Located on the web server, (Col. 27, lines 11-14). Once the CGI script receives the information from the POST command, the CGI script decodes the image into a binary file format., (Col. 27, lines 44-48). The CGI file then creates an HTML file used to insert the image into a web-based e-mail message. Lloyd indicates that the image also can be included in the e-mail message without an HTML file.

Claim 1 is an independent claim, and distinguishes over the cited art based at least upon the following claim limitations:

- generating the prepared message at a source location;
- commencing a first transmission from the source location to a destination address, the first transmission comprising a mail notice, the mail notice excluding the prepared message, the mail notice comprising a source address, a destination address and a message identifier, the message identifier comprising a code for identifying the prepared message;
- packaging at the source location the prepared message and the message identifier for said prepared message into a mail message using a binary formatting protocol;
- commencing a second transmission from the source location to a forwarding server, the second transmission comprising the mail message, wherein the second transmission is independent of the first transmission.

Neither Kowaguchi nor Lloyd et al. disclose two independent transmissions from the source location where the e-mail originates, in which one transmission includes a message

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identifier without a prepared message and the other includes the prepared message. Further neither Kowaguchi nor Lloyd et al. disclose the transmission of a message identifier from the source location. In Kowaguchi, the electronic mail server generates and transmits an indication of an electronic mail received at the server for a destination. Such indication is created at the server, and is not a message identifier.

Claims 2 and 3 depend from claim 1, and distinguish over the cited art based at least upon the same reasons as given for claim 1.

B. Claims 4, 6, 7, 9, 10, 11, 13 and 14 have been rejected under 35 USC 103(a) as being unpatentable over Kowaguchi in view of Lloyd and further in view of EP 1,259,036 (Yabe et al.)

Yabe et al. disclose an e-mail distribution method and server for use with mobile phones. An e-mail message is sent from a terminal connected to the internet and destined for a mobile station, (Col. 8, line 31-34). A gateway server receives the e-mail and forwards it to an e-mail delivery-managing unit, which stores the e-mail in a mailbox, (Col. 8, lines 36-40). Thereafter, the e-mail delivery-managing unit transmits an e-mail arrival notice to the mobile station. A status indication is received, such as communication possible, communication busy, or communication impossible, (Col. 2, lines 22-37; also Cols. 9-10). When communication is established, the e-mail delivery-managing unit transmits the e-mail to the mobile station, (Col. 10, lines 42-51).

It is noted that Yabe et al. does not disclose two transmissions from the source location where the e-mail originates. Further Yabe does not disclose the transmission from the source location of a message identifier without a corresponding prepared message, in which the message identifier comprises a code for identifying the prepared message.

Claim 4, 6 and 7 ultimately depend from claim 1, and distinguish over the cited art based upon the same reasons as given for claim 1. **Claim 4** further distinguishes over the cited art based at least upon the following claim limitations:

- wherein the step of responding comprises contacting the forwarding server with the message identifier specified within the mail notice and contacting the source address specified within the mail notice
- determining which one of the source address and the forwarding server respond first to contact with the destination address; and
- commencing receipt of a transmission of the mail message in the binary formatting protocol from the one of the source address and forwarding server which responds first to contact with the destination address.

It is noted that Yabe teaches that the mobile station responds to the server. Yabe et al. do not disclose a mobile station attempting to contact both the server and the source address of the message. Yabe et al. do not disclose determining which responds first. Further, Yabe et al. do not disclose receiving the message from the one that responds first. Yabe et al contact the server and receive the message stored at the server.

Claim 6 depends from claim 4 and distinguishes over the cited art for the same reasons as given for claim 4. Claim 6 further distinguishes over the cited art based at least upon the following claim limitations:

- receiving contact at the source address from the destination address;
- responsive to receiving contact at the source address, determining whether transmission of the mail message from the source location to the forwarding server is incomplete;

- when transmission to the forwarding server is still incomplete, pausing transmission of the mail message from the source location to the forwarding server, and
- transmitting the mail message from the source location to the destination address using the binary formatting protocol.

Yabe et al. do not disclose a mobile station attempting to contact both the server and the source address of the message. Yabe et al. do not disclose determining which responds first, nor receiving the message from the one that responds first. Yabe et al. do not disclose evaluating whether the transmission from the source to the server is still ongoing once the destination responds to the first transmission, nor of pausing the second transmission when the destination responds to the source.

Claim 7 depends from claim 6 and distinguishes over the cited art for the same reasons as given for claim 6. Claim 7 further distinguishes over the cited art based upon the following claim limitations:

- when transmission of the mail message from the source location to the destination address fails, resuming transmission of the mail message from the source location to the forwarding server; and
- when transmission of the mail message from the source location to the destination address succeeds, aborting transmission of the mail message from the source location to the forwarding server.

Claim 9 is in independent format and distinguishes over the cited art based at least upon the following claim limitations:

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- a mail program which processes the prepared message at the source computer to generate a mail notice and a mail message, the mail notice comprising a message identifier corresponding to the prepared message and a source address, the mail notice not including an entirety of the prepared message, the mail message comprising the prepared message in a prescribed format and the message identifier;
- means for establishing a first communication link between the source computer and the forwarding server along which the mail message is transmitted in a first transmission; and
- means for establishing a second communication link between the source computer and the destination computer along which the mail notice is transmitted in a second transmission, wherein the second transmission is an independent transmission different than the first transmission.

The cited art does not disclose two independent transmissions from the source location where the e-mail originates, in which one transmission includes a message identifier without a prepared message and the other includes the prepared message.

Claims 10, 11, 13 and 14 depend ultimately from claim 9 and distinguish over the cited art based at least upon the same reasons as given for claim 9. Further, claims 11, 13 and 14 add similar limitations to claim 9 as claims 4, 6 and 7 add to claim 1. Accordingly, claim 11 further distinguishes over the cited art based upon the same reasons as given for claim 4. Claim 13 further distinguishes over the cited art based upon the same reasons as given for claim 6. Claim 14 further distinguishes over the cited art based upon the same reasons as given for claim 7.

C. Claims 5 and 12 have been rejected under 35 USC 103(a) as being unpatentable over

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Kowaguchi in view of Lloyd et al., Yabe et al., and US Patent No. 5,293,250 (Okumura).

Okumura et al. disclose a system for notifying a destination terminal that an electronic mail has reached a host computer.

Claim 5 depends from claim 4 and distinguishes over the cited art based at least upon the same reasons as given for claim 4. **Claim 12** depends from claim 11 and distinguishes over the cited art based at least upon the same reasons as given for claim 11. Claims 5 and 12 further distinguish over the cited art based at least upon the following claim limitations:

- suspending contact with the other one of the source address and forwarding server;
- upon successful receipt of the mail message, notifying the sending address and the forwarding server that the mail message has been successfully received.

Neither Yabe et al. nor Okumura disclose a destination attempting to contact both the server and the source address of the message. Further, neither reference discloses a determination of which of the source and server responds first, nor receiving the message from the one that responds first. Yabe et al. contact the server and receive the message stored at the server. Still further, neither Yabe et al. nor Okumura suspend contact with the other one of the source and server, once contact is established with one of the source and server.

D. Claim 8 has been rejected under 35 USC 103(a) as being unpatentable over Kowaguchi in view of Lloyd and further in view of U.S. Patent No. 6,047,326 (Kilkki). **Kilkki** discloses a system for charging for usage of a network service connection. **Claim 8** depends ultimately from claim 1 and distinguishes over the cited art based at least upon the same reasons as given for claim 1.

E. Claim 15 has been rejected under 35 USC 103(a) as being unpatentable over Kowaguchi in view of Lloyd et al., Yabe et al., and Kilkki. **Claim 15** depends from claim 9, and distinguishes over the cited art based at least upon the same reasons as given for claim 9.

F. Claim 16 has been rejected under 35 USC 103(a) as being unpatentable over Kowaguchi

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in view of Lloyd, Yabe et al., and further in view of US Patent No. 6,073,142 (Geiger).

Geiger discloses a system which implements business communication policies for controlling the handling of e-mail messages by a data server to selectively gate, delete, forward, copy, release or return e-mail messages. (Col. 3, lines 3-13).

Claim 16 is an independent claim that distinguishes over the cited art based at least upon the following claim limitations:

- generating at a source location the prepared message and a message identifier, the message identifier comprising a code for identifying the prepared message;
- sending the message identifier corresponding to the prepared message from the source location to a destination address, the message identifier being sent to the destination address without the prepared message;
- packaging the prepared message and the corresponding message identifier into a mail message using a binary formatting protocol;
- commencing transmission of the mail message from the source location to a forwarding server;

The cited art does not disclose two transmissions from the source location where the e-mail originates, in which one transmission includes a message identifier without a prepared message and the other includes the prepared message. Further the cited art does not disclose the transmission of a message identifier from the source location without the prepared message.

G. Claim 17 has been rejected under 35 USC 103(a) as being unpatentable over Kowaguchi in view of Loyd et al, Yabe et al., Geiger et al. and Kilkki. **Claim 17** depends from claim 16 and distinguishes over the cited art based at least upon the same reasons as given from claim 16.

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Conclusion

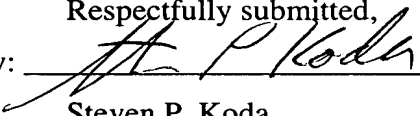
In view of the above remarks regarding the cited art, it is respectfully submitted that the claims contain key limitations that are not present in the cited art and not obvious from the cited art. These particular limitations are not disclosed in or suggested by cited references. These limitations are significant advances over the prior art and resulted in a novel method and apparatus for transmitting e-mail messages.

In view of the above amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance. The Examiner's action to that end is respectfully requested. Reconsideration of the claims and withdrawal of the rejections is respectfully requested.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the application, the Examiner is invited to call the undersigned attorney at the telephone number given below.

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